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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,046	02/05/2004	Philip R. Houston	BUSI-P01-001	5450
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ROPES & GRAY LLP PATENT DOCKETING 39/41 ONE INTERNATIONAL PLACE BOSTON, MA 02110-2624			EXAMINER McCORMICK, GABRIELLE A	
			ART UNIT 3629	PAPER NUMBER
			MAIL DATE 05/01/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/773,046

Applicant(s)

HOUSTON, PHILIP R.

Examiner

Gabrielle McCormick

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SI/302)
- Paper No(s)/Mail Date 3/24/2009
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

1. This action is in reply to the amendment filed on March 24, 2009.
2. Claims 1, 3 and 6-10 have been amended.
3. Claims 11-17 have been added.
4. Claims 1-17 are currently pending and have been examined.

Information Disclosure Statement

5. The Information Disclosure Statement filed on March 24, 2009 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Specification

6. The amendment to the specification filed March 24, 2009 is entered.

Requirement for Information Under 37 C.F.R. § 1.105

6. Applicant and the assignee of this application were previously required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.
7. The information is required to identify publications embodying the disclosed subject matter of a method and system for facilitating a sale of a product from an inventory of a selling entity. The Examiner upon conducting a search for prior art discovered a published document entitled: "Is Your CEO Lying? – Barron's cover". Notablecalls1. June 24, 2006 at <http://notablecalls1.blogspot.com/2006/06/is-your-ceo-luing-barrons-cover.html>.

8. In response, Applicant has reiterated that "all known and readily available documents and materials describing any product or service that incorporates the claimed subject matter for the time period beginning with the Spring of 2001 and continuing through February, 5, 2002" were submitted in the IDS of July 31, 2008.
9. Within Applicant's submissions was a letter dated February 26, 2002, from "Security Training, Inc." (STI) that discloses a "Deceptive Behavior Detection and Strategic Elicitation" course that was conducted prior to the date of the letter ("In addition to the core training program that **was the** focus of our recent introductory session in New York (described in the enclosed materials)..." (pg. 1; para. 3). The enclosed material lists Philip R. Houston as the expert. It is presumed by the Examiner that Philip R. Houston is the same Philip Houston that is the inventor of the instant application, therefore, the Examiner requests that the Applicant provide the nature of the relationship of STI and BIA. Further, the Examiner expands the request for information to include **all** course materials, written and video, (not just promotional excerpts) and the **dates** of **all** courses relating to deceptive behavior detection that were conducted prior to February 26, 2002. Additionally, please provide any training materials that were used to train financial, human resource, auditing and other key professionals (see pg. 1; para. 2 of the letter) to detect deceptive behavior.
10. Applicant responded that Security Training, Inc. was a previous name of BIA. The Examiner notes, however, that other than the above statement regarding the completeness of the IDS submission of July 2008, Applicant has not provided any course materials, training materials or dates of courses (referenced in the February 26, 2002 letter) as requested above.

Claim Rejections - 35 USC § 101

11. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

12. Claims 1-5 and 7-12 are rejected as being directed to non-statutory subject matter. Independent claim 1 is a method claim that recites process steps that are not tied to a particular machine. Based on recent Federal Circuit decision (see *In re Bilski*), an applicant may show that a process claim satisfies 35 USC 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. (See Benson, 409 U.S. at 70). First, as illustrated by Benson, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. (See Benson, 409 U.S. at 71-72). Second, the involvement of the machine or transformation in the claimed process **must not merely be insignificant extra-solution activity**. (See Flook, 437 U.S. at 590).
13. Though claim 1 recites the use of a display, the act of displaying on a display is merely insignificant extra-solution activity. The identification of a stimulus, the determination of a cluster of deceptive behaviors occurring within a time interval and the annotation of the record are activities that are not tied to a particular machine. In the context of the claim, these activities are performed by a human being, therefore, the only activity tied to a machine is displaying. Though Applicant asserts that the annotator is a particular machine, the Examiner disagrees. P[0040-0041], page 16, discloses that the reviewer (i.e., a human being) notes the question and cluster information. The decisions regarding the annotations are made by the reviewer, not a particular machine. The use of annotator 580 by the reviewer merely provides insignificant extra-solution activity as the reviewer performs the annotation by referencing a list of deceptive behaviors (page 20).
14. Because the applicable test to determine whether a claim is drawn to a patent-eligible process under 35 USC 101 is the machine-or-transformation test set forth by the Supreme Court, claim 1 fails that test and is therefore rejected under 35 USC 101.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claims 1-7, 9-15 and 17** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vrij et al. ("People's insight into their own behaviour and speech content while lying". British Journal of Psychology. London: May 2001. Vol. 92 Part 2. pg. 373, hereafter referred to as "Vrij") in view of Johnson, JR. (US Pub. No. 2002/0062089, hereinafter referred to as "Johnson") in view of Barboza ("Smith Barney Agrees to Settle Bond Charges for \$2 Million". New York Times. (Late Edition (East Coast)). New York, N.Y.: Sep. 24, 1997. pg. D. 10) in view of Weber et al. (US Pat. No. 5,564,005, hereinafter referred to as "Weber").

17. **Claims 1,6, 12 and 13:** Vrij discloses

- *receiving a record of a disclosure made by a representative*, (pg. 1; para. 2: 86 nurses were interviewed; interviews (i.e., records) were videotaped, transcribed and scored by independent coders; pg. 5; para. 5)
- *identifying within the record a stimulus given to the representative*, (pg. 3; para. 5: participants were asked questions (the question is a stimulus). The interviews were videotaped, transcribed and scored. (pg. 1; para. 2)).
- *reviewing the record to determine the presence of a cluster of two or more deceptive behaviors responsive to the stimulus*, (pg. 2, para. 4: 11 CBCA criteria (found in Appendix 1) were used in the study; and pg. 4; para. 10: raters scored "for each of the three answers the presence or absence of each of the" criteria (i.e., behaviors). Thus, clusters of CBCA behaviors were determined when two or more CBCA criteria are scored as present for each of the three questions.)

18. Vrij does not disclose a display, determining a cluster of behaviors that occur within a time interval of the beginning of the stimulus and a predetermined period of time after the end of the stimulus or analyzing a disclosure related to the performance of an entity associated with the representative or annotating the record using an annotator.
19. Johnson, however, discloses determining whether a subject responds deceptively by monitoring the subject's electrophysiological activity, behavioral activity, or both in response to stimuli (P[0010]). Behavioral markers are used to detect deception when a subject responds deceptively to a stimulus and the number of markers can be summed to indicate deception (i.e., a cluster is determined) (P[0092]). A time interval of the onset of the stimulus to 1-2 sec after the stimulus is used to time the subject's response, (P[0111]) thus a cluster is determined within a predetermined time interval.
20. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included starting a predetermined time period with the beginning of the stimulus, as disclosed by Johnson for the motivation of establishing a reference point for collecting data. It is old and well known to collect data over a period of time and as Vrij discloses collecting various behavioral data (pg. 3, para 6 – pg. 4; para. 7), it is obvious to begin collecting these types of data at the onset of the stimulus.
21. Further, Vrij discloses behavioral data collected with regard to detecting deception. Johnson discloses collecting data regarding deceptive markers both with the onset of the stimulus and after the stimulus. As data collection and various observable time frames for collecting data are well known in the art, it is obvious to combine these well known methods as the combination will produce the predictable results of data collection within a known time frame.
22. Barboza discloses that Smith Barney "regrets that it did not detect and prevent this deception by one its former employees" and had "hired a consultant to review some of its procedures". (para. 9 and 11).
23. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included studying the deceptive behaviors of financial managers, as disclosed

by Barboza in the system disclosed by Vrij, for the motivation of providing a method of understanding the correlation of lying to behaviors as it relates to financial managers for the purpose of detecting and preventing fraud. Vrij teaches the behaviors of liars (pg. 1; para. 3) while Barboza teaches the need in the financial world to detect deception (para. 8 and 9). Therefore, it's obvious that managers lie and there exist documented behaviors that can aid in the detection of the deception.

24. The Examiner notes that the type and content of disclosure is **nonfunctional descriptive data** and are not functionally involved in the steps recited. **The detection of deception behavior would be performed regardless of the nature of the disclosure analyzed.** Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
25. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included corporate disclosures because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of a type of data analyzed does not patentably distinguish the claimed invention.
26. Weber discloses the annotation of recorded events in a business domain (C1; L38-67) and an output device for display (C5; L66-67).
27. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included displaying and annotating a recording, as disclosed by Weber, in the system of Vrij for the motivation of correlating user-produced notes or information about an event to recorded signals of the event in order to provide greater collaboration. (Weber; C1; L40-45).
28. The Examiner notes that the content of the annotation is **nonfunctional descriptive data** and is not functionally involved in the steps recited. **The annotation of the record would be performed regardless of the descriptive content of the annotation.** Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re*

Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

29. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included annotations that includes the numbers of behaviors within a cluster of behavior, the stimulus, subject of the stimulus and the reply because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of annotation data does not patentably distinguish the claimed invention.
30. **Claims 2-5, 14:** Vrij discloses questions (pg. 3; para. 5), verbal (pg. 4; para. 10) and non-verbal responses (pg. 5; para. 5), topics (pg. 3; para. 5: each question is a topic), time periods (pg. 4; para. 6: latency period), representatives (pg. 1; para. 2: 86 nurses), interviewers (pg. 2; para. 3: 2 interviews for each nurses, one in which they were instructed to tell the truth, another in which they were instructed to lie).
31. **Claim 7:** Vrij/Johnson does not disclose that the pre-determined period of time is five seconds.
32. Johnson, however, discloses a specific time interval of stimulus onset to 1-2 seconds after the stimulus. (P[0111]).
33. Though Johnson does not disclose approximately 5 seconds, this difference is only found in the **nonfunctional descriptive data** and is not functionally involved in the steps recited. **The review of the behavior (i.e., data collection) would be performed regardless of length of the time period.** Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
34. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included five seconds because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the length of the time interval does not patentably distinguish the claimed invention.

35. **Claims 9 and 10:** Vrij discloses a cluster of two of a same behavior (e.g., speech errors) and a cluster of different behaviors (latency period (i.e., non-verbal) and speech errors (i.e., verbal)). (pg. 3; para. 6 – pg. 4; para. 7).
36. **Claims 11 and 17:** Vrij does not disclose indicating a likelihood of deception based on the number of deceptive behaviors in a cluster.
37. Johnson, however, discloses computing a ranges of scores based on the number of markers for indicating probable deception, probable truth and indeterminate. (P[0092]).
38. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included indicating a likelihood of deception based on the number of behaviors, as disclosed by Johnson, in the system of Vrij for the motivation of correlating the behavior data to a summary indicator of deception to allow quick identification of a subject's responses with regard to overall deception.
39. **Claim 15:** Vrij discloses the liars are unaware of their own actual behavior during deception (pg. 1; para. 4). Vrij also discloses collecting behavior data during the subject interview. (pg. 3-4). Thus, as a subject makes a deceptive statement, the behavior data is collected based on the subject's own statements and thus results in the statement as a stimulus from which behavior data is collected.
40. **Claims 8 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Vrij et al. ("People's insight into their own behaviour and speech content while lying". British Journal of Psychology. London: May 2001. Vol. 92 Part 2. pg. 373, hereafter referred to as "Vrij") in view of Johnson, JR. (US Pub. No. 2002/0062089, hereinafter referred to as "Johnson") in view of Barboza ("Smith Barney Agrees to Settle Bond Charges for \$2 Million". New York Times. (Late Edition (East Coast)). New York, N.Y.: Sep. 24, 1997. pg. D. 10) in view of Weber et al. (US Pat. No. 5,564,005, hereinafter referred to as "Weber") in view of McFarling (US Pub. No. 2004/0117760).

41. **Claims 8 and 16:** Vrij discloses that liars have a significantly longer latency period than truth tellers (pg. 6; para. 4), therefore, the calculation of the latency period (a deceptive behavior) obviously requires the need to continue to collect data beyond a predetermined time period in order to fully collect the verbal and non-verbal data. Vrij also discloses the collection of non-verbal behavior data such as gaze aversion, smiling, frequency of movements (pg. 3-4). Vrij also collects speech error data and speech rate data. (pg. 4). Vrij does not disclose reviewing behaviors after a predetermined period of time but within a duration of a behavior.
42. McFarling, however, discloses collecting all user data up to a predetermined time, after which the amount of user data collected is limited. (Claim 4).
43. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have included continue data collection after a predetermined time, as disclosed by McFarling, in the system of Vrij for the motivation of accounting for variability in the length of subject's latency period and length of response to a question, as well as to insure that the data collection process is comprehensive. For example, in Vrij, a question is presented. The subject begins responding at 4 seconds (thus a latency period of 4 seconds is established) and continues to respond for several additional seconds. It is obvious that data collection would continue beyond the predetermined time interval of 5 seconds in order to collect all the verbal and non-verbal response data. Without providing the flexibility in time for data collection, an incomplete profile of the subject is created and the findings are skewed.

Response to Arguments

44. Applicant's arguments filed March 24, 2009 have been fully considered but they are not persuasive. The Examiner has provided detailed explanations of the references with respect to the claim interpretations, above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabrielle McCormick whose telephone number is (571)270-1828. The examiner can normally be reached on Monday - Thursday (5:30 - 4:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/G. M./
Examiner, Art Unit 3629

/JOHN G WEISS/
Supervisory Patent Examiner, Art Unit 3629